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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/999,308	12/29/1997	NOBUTSUGU FUJINO	FUJO14691	3706
26304	7590	10/22/2003	EXAMINER	
KATTEN MUCHIN ZAVIS ROSENMAN			ENG, GEORGE	
575 MADISON AVENUE			ART UNIT	
NEW YORK, NY 10022-2585			PAPER NUMBER	
			2643	

DATE MAILED: 10/22/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

08/999,308

Applicant(s)

FUJINO ET AL.

Examiner

George Eng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 August 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8-14 and 16-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-14 and 16-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 37.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/11/2003 has been entered.

### ***Response to Amendment***

2. This office action is in response to the amendment filed 8/11/2003 (paper no. 40).

### ***Information Disclosure Statement***

3. The information disclosure statement filed 8/27/2003 (paper no. 37) has been considered.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-6, 8-14 and 16-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shachar et al. (US PAT. 5,764,736 hereinafter Shachar) in view of Van Hoff et al. (US PAT. 5,919,247 hereinafter Van Hoff) and Goldman et al. (US PAT. 4,995,074 hereinafter Goldman).

Regarding claim 1, Shachar discloses a communication system as shown in figure 1 comprising a server (124) providing information, a terminal (100) communicating data with the server, and a communication network (122) connecting said server to said terminal (col. 7 line 38 through col. 8 line 26), wherein the system further comprises a temporary line disconnection unit for temporary disconnecting a line being used for primary data communication when a third party other than the server is being voice communicated during a data communication between the terminal and the server (figure 4b and col. 14 lines 2-20), a data fetch unit for automatically fetching data from the server to the terminal (figure 4a and col. 13 lines 7-40), a storage unit for storing data fetch by said automatic data fetch unit (col. 13 lines 62-66), wherein a data communicating process is preformed from a status at a point immediately before starting the voice communication when said server and said terminal resume the data communication (figure 4c, col. 12 lines 34-57 and col. 14 lines 41-51). Note while Shachar teaches the communication

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system is able to download information from the server during data communication in the storage unit and to access the storage unit in order to accomplish various tasks (col. 8 lines 51-67, col. 10 lines 33-49 and col. 11 lines 35-41) so that the communication is capable of providing virtual data communication during voice communication. Shachar differs from the claimed invention in not specifically teaching that the data fetch unit fetching data of web sites includes information, which a user requires. However, Van Hoff teaches a system for distributing data to clients over a network comprising a client system using a tuner process for downloading and storing entire web site contents on a local hard disk upon a request is made so that a user can access the web site contents without further network traffic (col. 2 line 50 through col. 3 line 9 and col. 12 line 63 through col.13 line 6). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Shachar in having the tuner process as taught by Van Hoff because it makes user friendly so that it makes possible to use an application from a particular web site even if client system is not connected to a network. Note while neither Shachar nor Van Hoff specifically teaches the temporary line disconnected unit mediates the disconnection and reassignment of the communication line to the voice communication without issuing any disconnected notification to the upper layer application. However, Goldman teaches a system for preventing loss of a data when a communication line is temporarily switched for an optional use by not passing disconnected notification signal to an upper layer application in order to maintain data session at a host computer during a suspension period (col. 4 line 42 through col. 5 line 11). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Shachar and Van Hoff in mediating the disconnection and reassignment of the communication

line to the voice communication without issuing any disconnected notification to the upper layer application, as per teaching of Goldman, because it prevents loss of data when a communication line is temporarily switched for an optional use.

Regarding claim 2, Shachar teaches the terminal obtaining a telephone number of the third party as information during the data communications (col. 10 lines 54-60).

Regarding claims 3-5, Shachar teaches the server comprising a telephone switch unit and the temporary line disconnecting unit provided in the terminal and the server for disconnecting between the terminal and the server when the terminal issues a request for voice communication with the third party (col. 11 line 7 through col. 12 line 49).

Regarding claims 6 and 8, Shachar discloses at least one unit provided on a server side for each user who receives a service of said server for managing personal information and communications status of each user (col. 9 lines 4-17 and col. 12 lines 23-49).

Regarding claims 9, 16 and 22, the limitations of the claims are rejected as the same reasons set forth in claim 1.

Regarding claim 10, 17 and 23, the limitations of the claims are rejected as the same reasons set forth in claim 2.

Regarding claims 11-13, 18-20 and 24-26, the limitations of the claims are rejected as the same reasons set forth in claims 3-5.

Regarding claim 14, 21 and 27-28, the limitations of the claims are rejected as the same reasons set forth in claims 6 and 8.

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6. Claims 29-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shachar et al. (US PAT. 5,764,736 hereinafter Shachar) in view of Goldman et al. (US PAT. 4,995,074 hereinafter Goldman).

Regarding claim 29, Shachar discloses a communication system as shown in figure 1 comprising a server (124) providing information, a terminal (100) communicating data with the server, and a communication network (122) connecting said server to said terminal (col. 7 line 38 through col. 8 line 26), wherein the system further comprises a temporary line disconnection unit for temporary disconnecting a line being used for primary data communication when a third party other than the server is being voice communicated during a data communication between the terminal and the server (figure 4b and col. 14 lines 2-20), wherein a data communicating process is preformed from a status at a point immediately before starting the voice communication when said server and said terminal resume the data communication (figure 4c, col. 12 lines 34-57 and col. 14 lines 41-51). Shachar differs from the claimed invention in not specifically teaches the temporary line disconnected unit mediates the disconnection and reassignment of the communication line to the voice communication without issuing any disconnected notification to the upper layer application. However, Goldman teaches a system for preventing loss of a data when a communication line is temporarily switched for an optional use by not passing disconnected notification signal to an upper layer application in order to maintain data session at a host computer during a suspension period (col. 4 line 42 through col. 5 line 11). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Shachar in mediating the disconnection and reassignment of the communication line to the voice communication without issuing any

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disconnected notification to the upper layer application, as per teaching of Goldman, because it prevents loss of data when a communication line is temporarily switched for an optional use.

Regarding claim 30, Shachar teaches the terminal obtaining a telephone number of the third party as information during the data communications (col. 10 lines 54-60).

Regarding claims 31-33, Shachar teaches the server comprising a telephone switch unit and the temporary line disconnecting unit provided in the terminal and the server for disconnecting between the terminal and the server when the terminal issues a request for voice communication with the third party (col. 11 line 7 through col. 12 line 49).

Regarding claims 34 and 36, Shachar discloses at least one unit provided on a server side for each use who receives a service of said server for managing personal information and communications status of each user (col. 9 lines 4-17 and col. 12 lines 23-49).

Regarding claim 35, Shachar teaches a data fetch unit for automatically fetching data from the server to the terminal (figure 4a and col. 13 lines 7-40), a storage unit for storing data fetch by said automatic data fetch unit (col. 13 lines 62-66), wherein the communication system is able to download information from the server during data communication in the storage unit and to access the storage unit in order to accomplish various tasks (col. 8 lines 51-67, col. 10 lines 33-49 and col. 11 lines 35-41) so that the communication is capable of providing virtual data communication during voice communication.

Regarding claims 37, 44 and 50, the limitations of the claims are rejected as the same reasons set forth in claim 29.

Regarding claims 38, 45 and 51, the limitations of the claims are rejected as the same reasons set forth in claim 30.



Regarding claims 39-40, 46-47 and 52-54, the limitations of the claims are rejected as the same reasons set forth in claims 31-33.

Regarding claim 41-42, 48 and 55, the limitations of the claims are rejected as the same reasons set forth in claims 34 and 36.

Regarding claims 43, 49 and 56, the limitations of the claims are rejected as the same reasons set forth in claim 35.

### ***Response to Arguments***

7. Applicant's arguments filed 11/27/2002 (paper no. 30) have been fully considered but they are not persuasive.

In response to applicant's argument that the prior art fails to teach or suggest to enable resumption of data communications by simply disconnecting the line used for data communication without providing disconnection notification to upper level applications, it appears that Goldman clearly teaches to suspend, i.e., disconnect, a line being used for a data sessions in order to allow a user to take an incoming call from a third party, i.e., to provide a voice communication with the third party, during the data session, and to enable automatically resume the data session when the user place the telephone instrument in on hook, i.e., terminate the voice communication (abstract and col. 2 lines 12-38), wherein an interface, read as a temporary line disconnected unit, providing in a host and a user terminal for suspending the line used for data communication and maintaining the data session during the suspension period by providing carrier signals to the user terminal and the host (col. 4 line 42 through col. 5 line 11). Note while the data session is maintained during the suspension period. It recognizes the

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interface as taught by Goldman disconnecting the line used for data communication without providing disconnection notification notice to upper level applications. In addition, the carrier signals are different from disconnection notices because the carrier signals is used for maintaining the data session during the suspension period so that the upper layer applications do not recognizes the disconnection of the line used for data communication in order to allow the user to take the incoming call from the third party and resume of data communication by simply terminating the voice communication. Thus, carrier signals are functioning as specified data. As a result, the claimed limitations are rejected by the combination of Shachar, van Hoff and Goldman.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., enable resumption of data communication by simply disconnecting the line used for data communication without providing disconnection notification to upper level application) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). According to each independent claim, the temporary line disconnection unit is merely defined to disconnect a line being used for data communications without issuing any disconnection notifications to an upper layer application of said terminal and said server when said terminal voice communicates with a third party other than said server through said communication network during the data communication when specified data is received, and automatically connecting said server to said terminal when the voice communications terminate. Thus, each claim fails to clearly define to enable resumption of

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data communication by simply disconnecting the line used for data communication without providing disconnection notification to upper level application.

***Conclusion***

8. This is a continuation of applicant's earlier Application No. 08/999,308. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks

Washington, D.C. 20231

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Or faxed to:

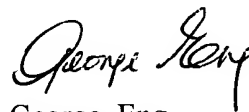
(703) 872-9306 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is (703) 308-9555. The examiner can normally be reached on Tuesday to Friday from 7 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (703) 305-4708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.



George Eng

Primary Examiner

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